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OFFICE OF PETITIONS

In re Application of	:	
Kubota et al.	:	
Application No.: 10/615289	:	DECISION ON
Filing or 371(c) Date: 07/09/2003	:	PETITION
Attorney Docket Number: 03500.017379	:	

This is a decision in response to the Renewed Petition Under 37 C.F.R. 1.181(a) and 37 C.F.R. 1.137(b) for Withdrawal of Notice of Abandonment, and Submission of Amendment which was Deemed to be Non-Compliant," filed September 8, 2008.

This Petitions are hereby **dismissed**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Noncompliant Amendment ("Notice"), mailed August 29, 2007. The Notice set a one (1) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). Applicant filed a reply to the Notice on October 25, 2007; however, the reply was not a complete and proper reply. No complete and proper reply having been received, the application became abandoned on September 30, 2007. A Notice of Abandonment was mailed April 8, 2008.

The Notice of Abandonment provides the following background: A first Notice of Noncompliant Amendment was mailed March 15, 2005, requiring replacement drawings and an amendment in compliance with 37 CFR 1.121. Applicants filed a response on April 18, 2005, with another non-compliant amendment. The amendment was non-compliant because the specification did not include marked-up paragraphs. Marked up paragraphs were included in "Applicant's Arguments/Remarks Made in an Amendment." Also noted was that the claims were not separately listed.

A second Notice of Noncompliant Amendment was mailed May 31, 2007, but listed only the failure to separately list all claims as the reason for noncompliance. The second Notice did not mention the failure to present replacement drawings. The second Notice also did not mention that marked up paragraphs were included in "Applicant's Arguments/Remarks Made in an Amendment," instead of the specification.

Applicant's responded to the second Notice on June 8, 2007, with another non-responsive amendment and no replacement drawings. Applicants presented a clean copy of the amended

specification for amendment, and with their remarks set forth the marked up paragraphs. No amendment to the specification in compliance with 37 CFR 1.121 was filed on June 18, 2007.

A third Notice of Noncompliant Amendment was mailed On August 29, 2007 requiring replacement drawings and a proper amendment to the specification. Applicants filed a response on October 25, 2007; however, again failed to file a proper amendment to the specification. Instead, Applicants argued that the marked up paragraphs filed June 8, 2007 were sufficient to amend the specification.

May 8, 2008 Petition under 37 CFR 1.181

Applicant filed a petition to withdraw the holding of abandonment on May 8, 2008, wherein Applicant stated, in relevant part, that "it was realized for the first time that what the examiner was requesting was [their] version of the January 3, 2005 Amendment, wherein the changes to the equations appeared with their entire paragraphs in the body of the Amendment showing to corrections therein, rather than in the attached marked up sheets." Petition at p.2.

Decision on Petition mailed July 7, 2008

The petition was dismissed in a Decision mailed July 7, 2007. The Decision dismissing the petition provided that in the present case, there was no dispute as to the sufficiency of the reply. Applicant acknowledged that it was realized for the first time that what the examiner was requesting was [their] version of the January 3, 2005 Amendment, wherein the changes to the equations appeared with their entire paragraphs in the body of the Amendment showing to corrections therein, rather than in the attached marked up sheets. There was no dispute as to whether the application is abandoned, Applicant's contentions merely involved the cause of abandonment.

The present renewed petition under 37 CFR 1.181

Applicant files the present renewed petition and reiterates that Applicant was unaware that the submission of marked up sheets showing the claim amendments was, or is, improper.

Applicable Law, Rules and MPEP

37 CFR 1.135, Abandonment for failure to reply within time period, provides that

- (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
- (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

MPEP 711.03(c)

Analysis and conclusion

The application became abandoned for failure to timely reply to the final Office action. Applicant has failed to demonstrate that a complete and proper reply to the office action was filed. Applicant admits states that it was unaware that the submission of marked up sheets showing the claim amendments was, or is, improper. However, a review of the prosecution history reveal Applicant was informed that its amendments were not in compliance with 37 CFR 1.121. Moreover, it is Applicant's responsibility to file a complete and proper reply in the first instance, as the condition of the case requires. While Applicants have demonstrated that timely replies to the Notices were filed, the Replies were not complete and proper.

Reconsideration under 37 CFR 1.181

If Petitioner files a second request for reconsideration of petition under 37 CFR 1.181, Petitioner is advised that after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply any and all relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence.

Petition under 37 CFR 1.137(b)Applicable Law, Rules and MPEP

A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Applicant lacks item (1) as set forth above.

Analysis and conclusion

As to item (1), the Examiner has reviewed the Amendment and concluded that the Amendment fails to place the application in condition for allowance. For clarification, and in order to advance prosecution of the application, the Examiner has provided the following comments:

The amendment within the 09/08/2009 Petition for review of the Abandonment is not proper because applicants did not show the markings of change required by 37 CFR

1.121 and then there is reference to the Abstract on the same page which according of the OG notice of 23 September 2003 is supposed to be on a separate page.

If applicants would take the section marked "SPEC" and dated 05/08/2008 from the Edan (public Pair) and add to the top of the first page "Amendment to the Specification" and enter that as the replacement for the non compliant amendment to the Specification from 05/08/2008 without any amendment to any thing else, then all non compliant issues would be taken care of.

There is already a compliant list of claims and a compliant set of Drawings and a compliant Abstract of record.

Applicants are not required to correct that which is already corrected, so only the properly marked up amendments to the Specification starting on and finishing on a separate set of pages from any thing else is required. The papers need to be clearly marked as an amendment to the specification as well.

The Examiner recommends the following for assistance in this matter:

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdtprac.htm>.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Director for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Inquiries regarding the Amendment should be directed to the Examiner. Telephone inquiries concerning this petition Decision should be directed to the undersigned at (571) 272-3232.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions